

REMARKS

Summary of the Office Action

Claims 6 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,209,772 to *Wang*.

Claims 1-3 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,651,491 to *Heaton et al.* ("*Heaton*").

Summary of the Response to the Office Action

Applicants have cancelled claims 6 and 7 without prejudice or disclaimer, amended claims 2-3 and 5. Accordingly, claims 1-5 are pending for further consideration.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement on January 17, 2007. Applicants thank the Examiner for acknowledging the Information Disclosure Statement by initialing the PTO 1449 form and returning a copy to Applicants.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 6 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection of claims 6 and 7 are moot in light of their cancellation. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §

112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,209,772 to *Wang*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Wang* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites the features of "a guide member with substantially parallel lateral sides for supporting an inner surface of the base portion of the staple legs during a process that the staple legs of the staple are penetrating the sheets." Similarly, newly amended claim 3 recites the features of "the guide member has substantially parallel lateral sides for supporting an inner surface of the staple along a portion of its staple legs during a process that the staple legs are penetrating a plurality of sheets." At least these features are not disclosed or taught by *Wang*.

Wang discloses a manual stapler that indicates how many staples are left within the stapler when being operated. See *Wang* at col. 1, lines 11-30. However, the manual stapler of *Wang* fails to teach or suggest at least the above features of claims 1 and 3.

The Office Action states that *Wang* discloses "a guide member (123) for supporting a side of the base portion of the staple leg from an inner side of the stapler during the process that the staple legs penetrate the sheets." Emphasis added. Please note the quoted term "stapler" above is not the recited claim term in claim 1 or 3. Applicants respectfully request that the

Examiner recognize his mischaracterization of the recited claim language and withdraw the rejections.

Nevertheless contrary to the Office Action's erroneous assertion, *Wang* discloses a spring plate (12) with a protection plate (123) that operates so that "the staple will be pushed out by the pressing plate 111 and guided by the protection plate 123." See *Wang* at col. 3, lines 1-9. *Wang* does not disclose "a guide member with substantially parallel lateral sides for supporting an inner surface of the base portion of the staple legs," or "the guide member has substantially parallel lateral sides for supporting an inner surface of the staple along a portion of its staple legs during a process that the staple legs are penetrating a plurality of sheets," as recited in claims 1 and 3. That is, the protection plate (123) of *Wang* does not support the inner surface of a base portion of the staple legs.

Further, assuming for the moment the protection plate (123) is the "guide member" as asserted, *Wang* does not disclose that the protection plate has "substantially parallel lateral sides" that support "an inner surface of the base portion of the staple legs." In fact, as seen in Figs. 5A and 5B, the protecting plate 123 (lateral sides or otherwise) does not even touch an inner surface of the base portion of the staple legs. Because *Wang* does not disclose these features, it cannot anticipate the invention recited in claims 1 and 3.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the

rejections under 35 U.S.C. § 102(b) should be withdrawn because *Wang* does not teach or suggest each feature of independent claims 1 and 3.

Additionally, Applicants respectfully submit that dependent claims 2 and 5 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 3, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1-3 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,651,491 to *Heaton et al.* (“*Heaton*”). Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Heaton* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites the features of “a guide member with substantially parallel lateral sides for supporting an inner surface of the base portion of the staple legs during a process that the staple legs of the staple are penetrating the sheets.” Similarly, newly amended claim 3 recites the features of “the guide member has substantially parallel lateral sides for supporting an inner surface of the staple along a portion of its staple legs during a process that the staple legs are penetrating a plurality of sheets.” At least these features are not disclosed or taught by *Heaton*.

Heaton discloses a surgical stapler for applying a plurality of surgical staples to body tissue. See *Heaton* at col. 1, lines 5-8. However, the stapler of *Heaton* fails to teach or suggest at least the above features of claims 1 and 3.

The Office Action states that *Heaton* discloses “a guide member (slot wall seen in Fig. 6b, not numbered) for supporting a side of a base portion of the staple leg from an inner side of the stapler.” Emphasis added. Please note the quoted term “stapler” above is not the recited claim term in claim 1 or 3. Applicants respectfully request that the Examiner recognize his mischaracterization of the recited claim language and withdraw the rejections.

Nevertheless contrary to the erroneous assertion, *Heaton* discloses slots (Fig. 6b, not numbered) in cartridge 22 from which staples 24 are ejected. See *Heaton* at col. 5, lines 19-30. *Heaton* does not disclose a guide member with substantially parallel lateral sides that support an inner surface of the base portion of the staple legs. The slots identified as cartridge 22 of *Heaton* do not support the inner surface of the base portion of the staple legs with substantially parallel lateral sides as required by claims 1 and 3. The walls of the slots support an outer surface of the staple legs, but not an inner surface of the base portion of the staple legs. Because *Heaton* does not disclose these features, it cannot anticipate the invention recited in independent claims 1 and 3.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Heaton* does not teach or suggest each feature of independent claims 1 and 3.

Additionally, Applicants respectfully submit that dependent claim 4 is also allowable insofar as it recites the patentable combinations of features recited in claim 3, as well as reciting additional features that further distinguish over the applied prior art.

Response to Response to Arguments

In response to the Office Action's statement that the "guide member of both Wang and Heaton et al. clearly shows all the recited structural limitations," Applicants have proven this to be false. Applicants have not argued that the inventions are differentiated by their differing functions at all. On the contrary, applicants have shown that the alleged guide members of *Wang* and *Heaton* do not have e.g., certain claimed structural features "for supporting an inner surface of the base portion of the staple legs" during stapling.

Secondly, the Office Action states that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." The Office Action continues by stating that "both Wang and Heaton et al. clearly show a guide member capable of supporting a portion of the staple leg during a stapling process." Here again, the Office Action mischaracterizes the claim language. The claim language does not state just "a portion of the staple leg," but rather recites "for supporting an inner surface of the base portion of the staple legs" and "for supporting an inner surface of the staple along a portion of its staple legs," in claims 1 and 3, respectively. Thus, the Office Action would have Applicants believe that support to any portion of the staple is sufficient to meet the recited claim language; however, this is not true. The alleged guide members in both *Wang* and *Heaton* cannot support the recited inner surface of the base portion of the staple legs and, therefore, cannot anticipate the present invention.

CONCLUSION

In view of the foregoing, Applicants respectfully request entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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